⊠ EPA/EPO/OEB D-80298 München ☎ +49 89 2399-0 TX 523 656 epmu d FAX +49 89 2399-4465	**Europäisches Patentamt** Generaldirektion 2	**European Patent Office** Directorate General 2	**Office européen des brevets** Direction Générale 2

Deans, Michael John Percy
M.J.P. Deans,
Lane End House
Hookley Lane
Elstead
Surrey GU8 6JE
ROYAUME-UNI

Telephone numbers:	
Primary Examiner (substantive examination)	+49 89 2399-6015
Formalities Officer / Assistant (Formalities and other matters)	+49 89 2399-2647

Application No. 00 950 386.3 - 2201	Ref. P10107EP	Date 20.10.2003
Applicant E-Dialog, Inc.		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).

MAY M
Primary Examiner
for the Examining Division

Enclosure(s):   2 page/s reasons (Form 2906)

The following documents are referred to in this communication; the numbering will be adhered to in the rest of the procedure:

> D1: 'YOU'VE GOT E-MAIL' PC WORLD, A.PC WORLD COMMUNICATIONS, INC. SAN FRANCISCO, US, vol. 16, no. 6, June 1998 (1998-06), pages 135-138,140, XP000907092 ISSN: 0737-8939
>
> D2: US-A-5 724 424 (GIFFORD DAVID K) 3 March 1998 (1998-03-03)

The present application does not meet the requirements of Article 52(1) EPC, because the subject-matter of claims 1, 4 and 5 is not new in the sense of Article 54(1) and (2) EPC. Furthermore, the above-mentioned lack of novelty notwithstanding, the subject- matter of claims 1,4 and 5 does not involve an inventive step in the sense of Article 56 EPC, and therefore the requirements of Article 52(1) EPC are not met.

1. Novelty

1.1 The document D1 discloses (the references in parentheses applying to this document):

A mailing list manager, comprising
(1) a memory means for storing answer examples (implicitly disclosed: mailing list manager anwers mail commands with prestored command outputs),
(2) a content selecting means for analyzing incoming e-mail messages (subscription commands, p.136, Get on the List, col.1, par.2),
(3) an answer selecting means for choosing appropriate reply contents (implicitly disclosed: subscription commands trigger subscription messages),
(4) a reply-mail preparing means for sending customized reply mail to the originato (The list server program may even be able to send it to you, p.137, Get on the List, col.2, par. 1)
("Get on the List", p.136).

The subject-matter of claims 1-5 is therefore not new (Article 54(1) and (2) EPC).

1.2 Inventive Step

Document D2 discloses (the references in parentheses applying to fig. 7 of this document):

A merchant computer system, comprising

(1) a memory means (Merchant Computer)

(2) a contents selecting means (33) for analyzing incoming web requests (32)

(3) an answer selecting means for choosing appropriate reply content (33)

(4) a reply-mail preparing means for sending customized reply mail to the originator (34)

from which the subject-matter of claims 1, 4 and 5 differs in that there is no disclosure of the usage of e-mail messages as communication means. The problem to be solved by the present invention may therefore be regarded as providing an alternative solution for a commercial electronic direct-response system. The skilled person confronted with said problem certainly would choose among a small number of alternative electronic communication means as mobile or facsimile communication, or electronic mails and would come up with a solution falling within the scope of claims 1, 4 and 5.

Consequently, the subject matter of claims 1, 4 and 5 does not involve an inventive step as required in Article 52 EPC.

1.3

Dependent claims 2 and 3 does not appear to contain any additional features which, in combination with the features of any claim to which it refers, meet the requirements of the EPC with respect to inventive step, the reasons being as follows. The feature of a reply adress setting means and a reply answer editor is a matter of normal design procedure. Its inclusions would therefore be an obvious design possibility for the skilled person in order to solve the problem posed.

2.

It is not at present apparent which part of the application could serve as a basis for a new, allowable claim. Should the applicant nevertheless regard some particular matter as patentable, an independent claim should be filed taking account of Rule 29(1) EPC. The applicant should also indicate in the letter of reply the difference of the subject- matter of the new claim vis-à-vis the state of the art and the significance thereof.

At least some of the objections raised above are such that there appears to be no possibility of overcoming them by amendment. Refusal of the application under Article 97(1) EPC is therefore to be expected.